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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,160	10/02/2001	Scott S. Lawton	CTK-001.01 (21910-101)	9597

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09/23/2005

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EXAMINER

VEILLARD, JACQUES

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/970,160

Applicant(s)

LAWTON, SCOTT S.

Examiner

Jacques Veillard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the Applicant's amendment filed on 8/12/2004.
2. Claims 25-33 have been canceled, and claims 34-42 have been substitute as new.
3. Claims 34-42 are pending and presented for examination.
4. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, based on the amendment filed on 8/12/2004, the finality of that action is withdrawn.

Claim Objections

5. Claims 35-40 are objected to because of the following informalities: the claims recite "the system recited in claim 25", claim 25 is a cancel claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
7. Claims 34-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The specification is silent regarding “a controller configured to receive from a user-input device...” the “controller” mentions on page 12 in the specification, is just word, and page 17, lines 3-5, states “a system running software configured as one or more components to display the category selector, accept user input, ...” but without undo experimentation one of ordinary skill in the art would be able to ascertain applicant’s claims invention. (See MPEP 2164.01(a)).

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 34-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is unclear from the specification (e.g., pages 12 and 17) and claims whether Applicant intends for a controller to be a hardware or combination hardware/software implementation, or whether Applicant’s intent is for it to include software alone. If it is the latter, claim 34 is directed to software per se, which is not statutory. Therefore, lacking the necessary hardware for any functionality to occur. Clarification and/or correction is required.

As per claims 35-40, they are rejected under the same basis in virtue of dependency.

10. As the Examiner can interpret the claims in light of the 112, first rejection and the 101, supra, the following rejection is given.

Claim Rejections - 35 USC § 102

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11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 34-40 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Wical (U. S. Pat. No. 6,112,201).

As per claim 34, Wical discloses a virtual bookshelf system to provide a user a way for browsing, viewing, selecting and locating information associated with a plurality of documents (See Wical Abstract, col.2, lines 15-33). In particular, Wical discloses the claimed limitations comprising a plurality of controls (See Wical Fig.1 in conjunction with component 110), each of which has two states: selected and not selected (See Wical Fig.1, and col.6, line 31 through col.7, line 17); a plurality of labels (See Wical Fig.2e in conjunction with element 300); a plurality of subgroup labels, each of which identifies a set of related controls (See Wical Fig.2c in conjunction with element 390); a controller configured to receive from a user-input device a single action associated with a control and toggle the state of this associated control without affecting the selection state of any other control (See Wical Fig.1 in conjunction with element 104, and col.6, lines 31-36); whereby a user can see at a glance which subgroups and options are available and thus more quickly locate relevant options(See Wical col.9, line 7 through col.10, line 38), and whereby a user can see at a glance which options are currently selected, making searches faster and easier (See Wical col.10, line 46 through col.11, line 17).

As per claim 42, most of the limitations of this claim have been noted in the rejection of claim 34. Applicant's attention is directed to the rejection of claim 34 above. Therefore, it is rejection on similar grounds corresponding to the arguments given for the rejected claim 34.

As per claim 35, Wical discloses the claimed limitations wherein every control is visible when the entire system is visible, whether or not the system itself is currently selected (See Wical Figs2a-2e, and col.11, line 18 through col.12, line 58).

As per claim 36, Wical discloses the claimed limitations wherein the single action is a click on a mouse button, a tap on a trackpad or equivalent action, by providing an input device such a mouse (See Wical col.10, lines 41-43).

As per claim 37, Wical discloses the claimed limitations wherein the single action is a key press such as on the space bar or enter key, by providing a button bar area that contains a number of buttons such as "space bar" and "enter key" to execute functions and commands (See Wical col.10, lines 36-41).

As per claims 38 and 39, Wical discloses the claimed wherein the subgroups indicated by the subgroup labels are arranged in a horizontal fashion as a single row, with each subgroup occupying a single column, and arranged as a set of rows and column, by providing a reference tables to display the contains of the categories in a horizontal fashion as a single row wherein

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each subgroup occupying a single column (See Wical Fig.1 in conjunction with reference table 150, and Figs.2c-2e).

As per claim 40, Wical discloses the claimed limitations wherein each control is a checkbox(See Wical col.10, lines 26-28, col.17, lines 46-49, and col.19, line 66 through col.20, line 6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wical (U. S. Pat. No. 6,112,201) in view of Fruensgaard et al. (U. S. Pat. No. 6,513,036).

As per claim 41, Wical discloses a virtual bookshelf system to provide a user a way for browsing, viewing, selecting and locating information associated with a plurality of documents (See Wical Abstract, col.2, lines 15-33). In particular, Wical discloses the claimed limitations comprising a plurality of controls (See Wical Fig.1 in conjunction with component 110), each of which has two states: selected and not selected (See Wical Fig.1, and col.6, line 31 through col.7, line 17); a plurality of labels (See Wical Fig.2e in conjunction with element 300); a plurality of subgroup labels, each of which identifies a set of related controls (See Wical Fig.2c in conjunction with element 390); a controller configured to receive from a user-input device a

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single action associated with a control and toggle the state of this associated control without affecting the selection state of any other control (See Wical Fig.1 in conjunction with element 104, and col.6, lines 31-36).

It is noted, however, Wical did not specifically disclose an information location mechanism coupled to a data repository containing a plurality of data objects, said information location mechanism being configured to receive search criteria, search the data repository, and retrieve data objects that conform to the search criteria; a formatting engine to format the search results from said information location mechanism; and a client process and visual display unit to display the search form, the formatted search results and the action trigger. On the other hand, Fruensgaard et al. disclose a method for searching and presenting search results from one or more information sources (See Fruensgaard et al. Title and abstract) includes an information location mechanism coupled to a data repository containing a plurality of data objects (See Fruensgaard et al. Abstract, and col.3, lines 11-41) said information location mechanism being configured to receive search criteria (See Fruensgaard et al. col.10, lines 39-54), search the data repository (See Fruensgaard et al. 1, lines 14-23), and retrieve data objects that conform to the search criteria (See Fruensgaard et al. col.1, lines 32-36); a formatting engine to format the search results from said information location mechanism (See Fruensgaard et al. col.12, lines 19-40); and a client process and visual display unit to display the search form, the formatted search results and the action trigger (See Fruensgaard et al. col.13, lines 47-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the virtual bookshelf of Wical by incorporating a search system mechanism as taught by Fruensgaard et al. The motivation being to have enhanced the system of Wical by

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allowing to provide easy and fast access to information which interests the user and enabling a user to select one or more references to review and collect references information in a collection of information (See Fruensgaard et al. col.4, lines 21-38).

Other Prior Art made Of record

- | | | |
|-----|-------------------|-------------------------------|
| 13. | Solimene et al. | U. S. Pat. No. 5,828,376, |
| | Hoeber et al. | U. S. Pat. No. 5,276,795, |
| | Valad | U. S. Pat. No. 6,727,921, |
| | Wynn et al. | U. S. Pat. No. 6,734,883, |
| | Chamberlin et al. | U. S. Pat. No. 6,941,317, |
| | Reder et al. | U. S. Pat. No. 6,727,919, and |
| | Morcos et al. | U. S. Pat. No. 6,384,849. |

Conclusion

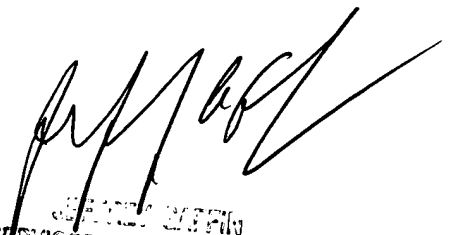
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086. The examiner can normally be reached on Mon. to Fri. from 9 AM to 4:30 PM, alt. Fri. off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272- 4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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SUPERVISORY PATENT EXAMINER
SEP 16 2005

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September 16, 2005